

#1576 Patent Docket No. H3691 PCT/US 10 11913

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

10 In re Application of:
Butterbach et al.

Serial No.: 09/807,837

Examiner: J. Gallagher

15 Filed: August 3, 2001

Art Unit: 1733

Title: Hot-Melt Adhesive For Glueing DVDs

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Declaration Under 37 CFR 1.131

25 Sir:

We, Ruediger Butterbach, Ulrike Erkens (because of marriage, formerly, Maassen), Dirk Bonke and Siegfried Kopannia, co-inventors of the subject matter of the above-identified patent application, declare as follows:

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- 1) That, at the time of the invention of the subject matter of this patent application, we were employed by Henkel KGaA, Dusseldorf, Germany, to whom this application has been assigned. At the time of invention, we were responsible for the development of new hotmelt adhesives for bonding together the various parts of DVD's ("digital versatile disc" or "digital video disc").
- 2) That, prior to August 26, 1998, we conceived and reduced to practice an adhesive composition and process for bonding together the two halves of

conventional DVD's having a sandwich construction. The adhesive composition is a hot-melt adhesive and is comprised of at least one thermoplastic elastomer, at least one hydrocarbon resin, at least one poly-alpha-olefin and at least one polar wax having functional groups.

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- 3) That, some time prior to April 21, 1998, we considered the deficiencies of conventional DVD adhesives, especially with regard to the "harsh climate test" to which DVDs are subjected. We ultimately determined that by formulating an adhesive with compounds having modified polarities we might create a stronger adhesive. We then diligently worked to produce such an adhesive.
- 4) That, on April 21, 1998 we prepared a hot-melt adhesive according to the invention. Now produced and shown to us and marked Exhibit A to this, our declaration, is a laboratory journal table dated April 29, 1998. The first entry in column 1 shows that the compositions listed on this journal were prepared on April 21, 1998 at Henkel's laboratory facilities in Dusseldorf, Germany. The fourth column shows a composition identified as "Q53xx-482". This composition meets all the limitations of the claims of the above-identified patent application. The composition consists of a hydrocarbon resin (Escorez 5320), a thermoplastic elastomer (Septon 2043), a poly-alpha-olefin (Vestoplast 408) and a polar wax having functional groups (A-C 573 P).
- 5) Now produced and shown to us and marked Exhibit B to this, our declaration, is a report entitled "Rheocalc V1.1 Brookfield Engineering Labs" which shows that viscosity measurements were taken April 30, 1998 of the composition identified in Exhibit A, Q53xx-482.
- 6) Now produced and shown to us and marked Exhibits C1 and C2 to this, our declaration, are the original and the English language translation, respectively, of the "Protocol of Invention", which is dated November 10, 1998. Exhibit C1 is a copy of the original document which discloses the facts pertaining to the discovery of this invention, entitled "Hotmelt for DVD". Specifically, the hot melt adhesive of the invention claimed in the above-identified patent application was first formulated for use as an adhesive for bonding together the two halves of a DVD on

April 21, 1998 (page 2, section 2 of Exhibit C1). Exhibit C2 is a true translation into English of Exhibit C1. This Exhibit also indicates that this invention is claimed in German patent application no. 198 48 146.2, filed on October 20, 1998. The German patent application is the priority application for the above-identified US patent application.

7) Declarants further state that the above statements were made with the knowledge that willful false statements and the like are punishable by fine and/or imprisonment or both, under Section 1001 of Title 18 of the United States Code and any such willful false statements may jeopardize the validity of this application or any patent resulting therefrom.

| 15 | Ruchiger Sullinbach Ruediger Butterbach | Augus 1 14, 2003 Date |
|----|---|--------------------------|
| | Umke Ekeuj Ulrike Erkens | September 3, 2003 Date |
| 20 | Dirk Bonke | Hy lust 14, 2003 Date |
| | Sieffrud Kaflemania | Syptemies 3, 2003 Date |

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| Entwicklung: Q 53XX | | | | | | | |
|---|------------------------|------------------------|------------------------|------------|--------------|-------------|---------------------------------------|
| Düsseldorf, den 21.04.1998 Laborjournal | Q 53xx-480 S. 74 ff | Q 53xx-481 S. 74 ff | Q 53xx-482 S. 74 ff | Q 53xx-483 | Q 53xx-484 | Q 53xx-485 | Q 53xx-486 |
| | 3. /4 11 | 3. 74 11 | | S. 74 ff | S. 74 ff | S. 74 ff | S. 74 ff |
| Escorez 5320 | | | 30,0 | 35,0 | | | |
| Escorez 5380 | 32,0 | 37,0 | | ļ | | | |
| Keltan 1446 A | | | | 14,5 | | | |
| Kraton G 1652 | | 11,0 | | | | | |
| Septon 2043 | 16,0 | | 19,5 | | | | |
| Vestoplast V 408 | 20,0 | | | | | | |
| Irganox 1010 | 0,5 | 0,5 | 0,5 | 0,5 | | | |
| Escor 5000 | - | | | | | | |
| Epolene E 43 | | ļ · | | 25,0 | | | |
| Epolene G XX15 | | | | 20,0 | | | |
| Epolene C 16 | 21,0 | 21,0 | | | | | |
| A-C 573 P | | | 25,0 | | | | |
| Lotader 8200 | 10,5 | 10,5 | 20,0 | | | | |
| Kontrollsumme: | 100,0 | | 100,0 | 100,0 | 0,0 | 0.01 | |
| | 100,0 | 100,0 | 100,0 | 100,0 | 0,0 | 0,0 | 0,0 |
| Erweichungspunkt °C | 109,3 | 103,9 | 114,2 | 150,8 | | | |
| Viskosität 160 °C | 5 1250 | 38350 | 39333 | 24120 | | | |
| Viskosität 170°C | | | | - 1.65 | | | |
| Viskosität 180 °C | 73050 | 18500 | 12 1212 | 8700 | | | · · · · · · · · · · · · · · · · · · · |
| Viskosität 200 °C | 13475 | 3600 | | 4950 | | | |
| Wärmestandfestigkeit [°C] PC/PC 0,02 N/mm² | | | 0000 | 7 3 3 | | | |
| 3.1 C C,52 (1.111111 | | | | | | | |
| Bemerkung: | | | | | | | |
| semerang. | | | · | | | | |
| | | | | | | | |
| Al (peel/schlagbelast.) PC (peel/schlagbelast.) | | | | | | | |
| (peerschagbelast.) | | | | | | | |
| SC-Messung: | | | | | | | |
| .Lauf: | | | | | | | |
| Hm (J/g) | | | | | | | |
| .Peakmax. (°C) | | | | | | | |
| Inset (°C) | | | | | | | |
| ndset (°C) | | | | | T T | | |
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| Hkrist. (J/g) | | | | | | | |
| g (°C) | | | | | | | |
| Peakmax. (°C) | | | | | | | |
| Lauf: | | | | | | | |
| Hm (J/g) | | | | | | | |
| Peakmax. (°C) | | | | - | | | |
| nset (°C) | | | | | | | |
| ndset (°C) | | | | | - | | |
| g (°C) | | | | | | | |
| Cp (J/g*K) | | | | | | | |
| andelsname | | | | | | | |

RHEOCALC V1.1 BROOKFIELD ENGINEERING LABS Exhibit B

| Model: Sample | | | e: SC4-27 Tab 43xx_3 | | 04/30/98 File: | | |
|------------------|------|-------|-------------------------|-------------------|-------------------|-------|-------|
| # | To | orque | Viscosity | Sh Str | Sh Rt | Temp | Time |
| | RPM | % | cP | D/Cm ² | 1/Sec | °C | MM:SS |
| 001 | 3.0 | 47.2 | 39333 | 401.2 | | 160.6 | 10:23 |
| 002 | 6.0 | 40.9 | 17042 | 347.7 | | 180.2 | 10:02 |
| 003 | 12.0 | 38.4 | 8000 | 326.4 | | 200.1 | 10:16 |

Page 1 of 1

Exhibit C.

SB: SC

X

| Nur für Vermerke | der Abteilun | g Erfindervergütung | Ausgeübt seit: | bis: |
|------------------|--------------|---------------------|----------------|------|
| EP/DBP | | | | |
| erteilt: | | | | |
| rechtskräftig: | | | | |
| Pauschal- | DM: | in: | | |
| regelung | DM: | in: | | |

Stichwort: Hotmelt für DVD

Internes Aktenz.: H 3691

Amtl. Aktenzeichen: 198 48 146.2

Innere Priorität von H beansprucht.

In Anspruch genommen am: 28. September 1998

Geheimgehalten. (Pat.Aussch. vom:)

Marktklasse(n): ALS2

Anmelder: Henkel KGaA

Anmeldetag: 20. Oktober 1998

beschränkt / unbeschränkt

vor Anmeldung / nach Anmeldung

Henkel KGaA

VTP

Datum: 10. November 1998

Erfindungsprotokoll (Ergänzende Angaben der Erfinder nach Arbn.Erf.G §5,2)

Titel: Schmelzklebstoff zur Verklebung von DVDs

1. Erfinder

(Reihenfolge der vorgesehenen Benennung gegenüber den Patentämtern):

| Name | erlernter Beruf | Organi- | Privatanschrift | Erfin- | Stellung in der Firma |
|------------------|------------------|----------|----------------------------|--------------|-----------------------|
| Vorname | Staatsangehörig- | sations- | (= Zustelladresse, solange | dungs- | zum Zeitpunkt der |
| Personalnummer | keit | einheit | keine Änderung | anteil | Erfindung; |
| (mit Firmencode) | | | gemeldet) | in % | Firma (wenn nicht |
| | | | | | Henkel KGaA) |
| 1. Butterbach, | DiplChem | ALS- | Neckarstraße 56 | 40 | Laborleiter |
| Rüdiger | Ing. | PD | 45219 Essen | | |
| 02 - 188018 | deutsch | | | | |
| 2. Maaßen, | Chemie- | ALS- | Neuenburger Str. 44 | 30 | Sachbearbeiterin |
| Ulrike | Laborantin | PD | 41470 Neuss | | |
| 02 - 170356 | deutsch | | | | |
| 3. Bonke, | Chemielaborant | ACT- | Hans-Christoph- | 15 | Werkstudent |
| Dirk | deutsch | PE/ | Seebohm Str. 13 | | |
| 02 - 372609 | | AWT | 40595 Düsseldorf | | |
| 4. Dr. Kopannia, | DiplChem. | ALS- | Ringofenweg 3 | 15 | Abteilungsleiter |
| Siegfried | deutsch | PD | 47809 Krefeld | | |
| 02 - 157872 | | | | | |
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. 2.

| 2. | Wann wurde die Ermidung gemacht? |
|----|--|
| | 21. April 1998 |
| 3. | Welches technische Problem (= "Aufgabe") löst die Erfindung? |
| | Eine Schmelzklebstofformulierung gemäß der Erfindung erlaubt die Herstellung von |
| | Digital Versatile Disks, geklebt mit Schmelzklebstoff, die auch die hohen |
| | Klimatestanforderungen überstehen. |

| 4. * | Liegt die Aufgabe auf dem allgemeinen Arbeitsgebiet der Erfinder? |
|-------------|---|
| (| ja |

a) Wenn "nein": bitte begründen:

(Bitte getrennte Angaben für die einzelnen Erfinder!):

b) Erfolgte ein direkter Auftrag für die Arbeiten, die zu der Erfindung führten? Nein

Wenn "ja":

- α) durch wen?
- β) Welche Hinweise auf den Lösungsweg der Aufgabe wurden gegeben?

Erfinder 1:

Erfinder 2:

Erfinder 3:

Erfinder 4:

(Weitere Erfinder ggf. einfügen)

ja/nein, bitte ggf. unterschiedliche Angaben für die einzelnen Erfinder eintragen. Bei nicht ausreichendem Raum bitte Zusatzblatt beilegen.

Wenn "nein": α) Was gab den Anlaß zu den Arbeiten, die zu der Erfindung führten?

3

β) Wie erlangten die Erfinder Kenntnis von Mängeln oder Bedürfnissen, denen durch die Erfindung abgeholfen

wird?

Die Erfinder 1 + 2 stellten im Labor fest, daß Schmelzklebstoffe trotz ausreichender Wärmestandfestigkeit den sog. harten Klimatest für DVD nicht bestehen. In gemeinsamen Diskussionen kamen beide Erfinder zu dem Schluß, daß die Haftung des Klebstoffs einen Einfluß auf diesen Test hatte.

Die Erfinder 1 + 2 kamen zu dem weiteren Schluß, daß die geeignete Haftung nur mit polar modifizierten Rohstoffen zu erreichen war.

Die weiteren technischen Probleme wurden in gemeinsamen Diskussionen der Erfinder 1-4 gelöst.

(Weitere Erfinder ggf. einfügen)

- 5° Lösung der Aufgabe:
 - a) Setzten die Erfinder Überlegungen ein, die auf ihre Berufsausbildung zurückgehen? (Wenn "nein": bitte begründen) nein.

 Die Klebstoffentwicklung war kein Bestandteil der Berufsausbildung aller Erfinder
 - b) Setzten die Erfinder Kenntnisse ein, die sie durch ihre Firmenzugehörigkeit erworben haben? (Wenn "nein": bitte begründen)

ja

c) Auf welchen Vorarbeiten der Erfinder oder anderer Firmenangehöriger baut die Erfindung auf?

- d) Auf welchen Patenten/Patentanmeldungen baut die Erfindung auf?
- e) Wurden übliche technische Hilfsmittel der Firma benutzt? Wenn "nein": bitte begründen:

ja

f) Mußten durch die Firma spezielle Hilfsmittel bereitgestellt werden? Wenn "ja": welche?:

Ja. Ein Meßgerät zur Bestimmung der Winkelverkippung einer optischen Disk Wurde für diese Erfindung benötigt.

ja/nein, bitte ggf. unterschiedliche Angaben für die einzelnen Erfinder eintragen. Bei nicht ausreichendem Raum bitte Zusatzblatt beilegen.

e)

| | | 5 |
|----|-----------------|--|
| 6. | Schöp Erfind | ferischer Beitrag jedes einzelnen Erfinders zum Zustandekommen der ung |
| | a) | Welcher Erfinder trug welche Ideen oder Verfahrensvorschläge zur Erfindung bei? |
| | | siehe Punkt 4 |
| | | |
| | b) | Gibt es Aspekte der Erfindung, die auf besondere Beiträge einzelner Erfinder zurückgehen? - Wenn "ja": welche und von wem? |
| | | nein |
| | | |
| | c) | Welcher Miterfinder wurde aufgrund von Anregungen oder Anweisungen eines anderen Miterfinders tätig? |
| | | Erfinder 3 wurde durch Anregungen und Anweisungen durch Erfinder 1 tätig. |
| | | |
| | d) | Haben sonstige Henkel/VU-Mitarbeiter oder außenstehende Dritte an der Erfindung mitgewirkt? - Wenn "ja", bitte Art und Umfang der Mitarbeit angeben. |
| | | nein |

Eventuell weitere Angaben zum Zustandekommen der Erfindung.

7. Unterschriften der Erfinder und ihrer Vorgesetzten (Bei externen Erfindern nicht erforderlich)

"Ich bestätige/wir bestätigen, daß die vorstehenden Angaben vollständig und zutreffend sind. Weitere Erfinder sind meines/unseres Wissens nicht beteiligt."

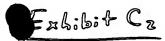
| Erfinder | Datum | Vorgesetzter (zum | Datum |
|---------------------------|------------|---|----------|
| (Bitte jetzige OrgEinheit | | Zeitpunkt der Erfindung) | |
| und Gebäudenummer | | Zonpanic del Zimidung) |] |
| angeben) | | | |
| 1. Rüdiger Butterbach | | | |
| / / | | id . | |
| R Bu Herbach | 11.12.98 | Rojama | 11.12.98 |
| ALS-PD, 201 | | | |
| 2. Ulrike Maaßen | | | |
| | 11.12.98 | R. Bullerbach | 11.12.98 |
| ALS-PD-ZO1 | | | |
| 3. Dirk Bonke | | | |
| Oil Bake | 11/12/98 | R. Bullerback | 11.12.98 |
| ACT- PE/AUT. VI | | | |
| 4. Dr. Siegfried Kopannia | | 7_ 1 | |
| Monumin | 44 43 63 | Tat hellians | 11 11 00 |
| ALS-PD, 204 5. | 101.112.38 | | 11.12.78 |
| 1925-PD, 209 | | ALS-PD, GO1 | |
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| 8. | Bemerkungen des Sac | chbearbeiters von VT | P |
|----|-----------------------|----------------------|------------------------|
| | (z.B. bestehende Vert | räge, bekannte Abhä | ngigkeiten von anderen |
| | Schutzrechten etc.) | | . 1 |
| | Relation ou | 112841 | su prinflu |

Zur Kenntnis genommen:

Sachbearbeiter VTP/ Datum

1. Luffe 14.12-98



| | Н | | | 1 | Enh | :b:{- | Cz |
|------|------------------|-------------------|---------------------|-------------------|------------------|-------|-------|
| · `. | | he Inventor Com | pensation Departmen | t only In use sin | nce: until: | | |
| | EP/DBP | | | | | | |
| | Granted: | | | | | | |
| | Legally valid: | | | | | | |
| | Lump-Sum | DM: | in: | | | | |
| | Settlement | DM: | <u>in:</u> | | | | |
| | | | | | | | |
| | Keyword: H | otmelt for DV | VD | Market segr | nent(s): ALS2 | | |
| • | Ref. No. H 36 | | | _ | Ienkel KGaA | | SB:SC |
| | Appl/Pat. No: | | 2 | _ | | | SD.SC |
| | 1 | | | Filing date: | October 20, 1998 | | |
| | Internal priori | ity claimed by | y H | | | | |
| | Invention formal | lly claimed on: S | Sept. 28, 1998 | limited | / unlimited | X | |
| | Declared as trad | e secret (PDT): | | before filing | ☐ / after filing | | |

Henkel KGaA

VTP

Date: November 10, 1998

Protocol of Invention (Supplemental Inventor Data according to § 5.2 of the Employee Invention Law)

Title of the Invention: Hotmelt Adhesive for Bonding DVDs

1. Inventors

| | T | | | Ţ | |
|----------------------|----------------|----------|-------------------------|--------------|-------------------------|
| Name | Profession | Business | Home Address | Share | Position at the time of |
| First Name | Nationality | Group | (= address for official | in the | the invention; |
| ID No. | | } | deliveries until | Inventi | company (if not |
| (incl. company code) | <u> </u> | | notification of change) | on (%) | Henkel KGaA) |
| 1. Butterbach, | Diplomate | ALS- | Neckarstrasse 56 | 40 | Laboratory Director |
| Rüdiger | Chemical Eng., | PD | 45219 Essen | | |
| 02 - 188018 | German | | | | |
| 2. Maaßen, | Chemistry Lab | ALS- | Neuenburger Str. 44 | 30 | Specialist |
| Ulrike | Assistant, | PD | 41470 Neuss | 1 | ' |
| 02 - 170356 | German | | | | |
| 3. Bonke, | Chemistry Lab | ACT- | Hans-Christoph- | 15 | Work-Study Student |
| Dirk | Assistant, | PE/ | Seebohm Str. 13 | | |
| 02-372609 | German | AWT | 40595 Düsseldorf | | |
| 4. Dr. Kopannia, | Diplomate | ALS- | Ringofenweg 3 | 15 | Department Head |
| Siegfried | Chemist, | PD | 47809 Krefeld | | |
| 02-157872 | German | | | | |
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| 2. | Date of the invention |
|----|-----------------------|
| | April 21, 1998 |

- 3. Which technical problem is solved by this invention?

 A hot-melt adhesive formulation according to the invention makes it possible to produce Digital Versatile Disks, bonded with hot-melt adhesive, which are also able to withstand extreme climatic requirements.
- 4.* a) Does this technical problem relate to the general field of activity of the inventors? *Yes*.

If "no" please specify:

(Please specify separately for each inventor!):

b) Did the invention result from direct instructions for the experiments? *No.*

If "yes":

- α) by whom?
- β) Which references to the solution have been given?

inventor 1:

inventor 2:

inventor 3:

inventor 4:

If "no":

- a) What triggered the work leading to the invention?
- β) How did the inventors gain knowledge of the deficiencies or needs which are improved or solved by the invention?

Inventors 1+2 discovered in the laboratory that hot-melt adhesives, in spite of adequate heat resistance, cannot withstand the so-called "harsh climate test" for DVDs. In joint discussions, the two inventors came to the conclusion that the adhesion of the adhesive had an effect on this test.

Inventors 1+2 came to the further conclusion that suitable adhesion was to be achieved only by the use of raw materials whose polarity has been modified.

The remaining technical problems were solved in joint discussions among inventors 1-4.

5* Solution of the problem:

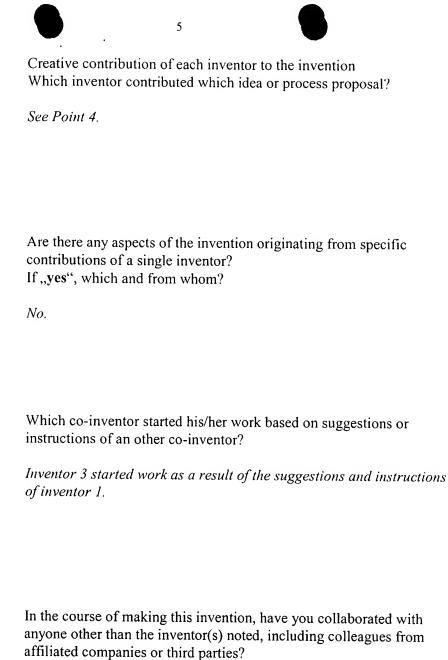
| Solut | Solution of the problem, | | | | |
|-------|--|--|--|--|--|
| a) | Are the considerations/thoughts used by the inventors based on their technical training? (if "no" please specify) No. The development of the adhesive was not a part of the professional training of any of the inventors. | | | | |
| b) | Did the inventors use knowledge acquired through their job in the company? (if "no" please specify) | | | | |
| | Yes. | | | | |
| c) | Does this invention relate to any previous works of the inventors or colleagues? | | | | |
| | | | | | |
| | | | | | |
| | | | | | |
| d) | On which patents/applications is this invention based? | | | | |
| e) | Have usual technical facilities of the company been used? If "no" please specify: | | | | |
| | Yes. | | | | |
| f) | Was it necessary to provide special facilities? If "yes" which?: | | | | |
| | Yes. A measuring instrument for determining the angular tilt of an optical disk was required for this invention. | | | | |

6.

a)

b)

c)



d) affiliated companies or third parties? If "yes", please specify type and extent.

No.

e) Further relevant information relating to this invention 7. Signatures of the inventors and supervisors

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Н

"I (We) confirm that the information given above is complete and true. To the best of my/our knowledge I/we are the sole inventors."

| Inventor (current business group) | Date | Supervisor (at the time of invention) | Date |
|---------------------------------------|----------|---------------------------------------|----------|
| 1. Rüdiger Butterbach [signature] | 12/11/98 | [signature] | 12/11/98 |
| 2. Ulrike Maaßen [signature] | 12/11/98 | [signature] | 12/11/98 |
| 3. Dirk Bonke [signature] | 12/11/98 | [signature] | 12/11/98 |
| 4. Dr. Siegfried Kopannia [signature] | 12/11/98 | [signature] | 12/11/98 |
| 5. | | | |
| 6. | | | |
| 7. | | | |

8. Remarks of the patent referee of TTP (e.g. existing contracts, known dependencies from other patents etc.)

relationship with H 2841 should be checked

Acknowledged:

Patent Referee TTP/ date